No. 22,059

United States Court of Appeals

For the Ninth Circuit

REIN J. GROEN and WILLIAM A. RICE,
Appellants,

vs.

LUSTIG FOOD CORPORATION, et al.,
Appellees.

Appeal from the Summary Judgment of the United States District Court for the Northern District of California
Honorable Robert F. Peckham, Judge

APPELLANTS' OPENING BRIEF

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JURISDICTIONAL STATEMENT

This is an appeal from an Order Granting Motion for Summary Judgment entered on December 30, 1966, in the District Court of the United States for the Northern District of California, declaring United States Letters Patent No. 2,950,203 invalid and granting summary judgment to defendant General Foods Corporation (Clerk's Transcript 36-38). The action originally arose from a complaint for infringement of patent under the patent laws of the United States, and more particularly under 35 U.S.C. 271 and 281. Jurisdiction was conferred on the district court by 28 U.S.C.A. 1338. Plaintiffs filed a timely Notice of Appeal on January 26, 1967 (CT 46), and jurisdiction is conferred upon the U.S. Court of Appeals by 28 U.S.C.A. 1291.

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OPENING STATEMENT

This appeal arises out of an Order Granting Motion for Summary Judgment against plaintiffs and appellants in an action for infringement of patent.

Letters Patent No. 2,950,203 were issued to appellants on August 23, 1960, relating to the process of quick-freezing raw onions. The claim of the patent is as follows (Clerk's Transcript 5):

> "The process of quick-freezing raw onions which comprises sorting the opinions, peeling and trimming the onions to remove unedible and undesirable portions thereof, washing the peeled and trimmed onions, cutting the onions into pieces,

carrying the onion pieces while unconfined through a freezing zone and effecting an individual freezing operation on each onion piece at least as cold as substantially zero degrees F., and then packaging the onion pieces, the entire process being carried out at substantially ambient atmospheric temperatures."

Defendant General Foods Corporation is the only defendant remaining in the case, and is the moving party for the summary judgment. Its motion for summary judgment was predicated upon the following grounds:

a. Invalidity of the Letters Patent;

b. Non-infringement by General Foods Corporation.

SUMMARY JUDGMENT IMPROPER ON ISSUE OF VALIDITY OF PATENT

It is a cardinal rule that there is a presumption that every issued patent is valid. (Section 282, Title 35, U.S. Code: "A patent shall be presumed valid.") (See also *H. J. Heinz Company v. Cohn,* 207 F. 547.) Granting of a patent carries with it the presumption of novelty and constitutes prima facie evidence that the patentee is the first inventor of the invention disclosed in the patent. (See Section 282 of Title 35 of U.S. Code.) The burden of proof of want of novelty rests upon him who avers it, and every reasonable doubt should be resolved against him. (*Coffin v. Ogden,* 85 U.S. 120.)

Patents for inventions are to receive a liberal construction. Under the fair application of this rule, patents should, if practicable, be so interpreted as to uphold and not to destroy the right of the inventor. (*Turrill v. Railroad Co.,* 68 U.S. 491.)

Moreover, although Rule 56 authorizes the motion for summary judgment, this is an extreme remedy and proper only where no genuine issue as to a material fact exists and where it is appropriate in order to avoid the expense of trial and the preparation for trial. (*Sequoia Union High School District v. U. D.,* 245 F. 2d 227.) All doubts are to be resolved against the moving party. The material allegations of appellants' complaint must be accepted as true, and they must be given the benefit of the most favorable inferences which reasonably can be drawn therefrom. (*Jeffrey v. Whitworth College,* 128 F. Supp. 219.) Summary judgments should be granted only in cases where it conclusively appears from the record that there is no genuine issue as to a material fact. (*Booth v. Barber Transp. Co.,* 256 F. 2d 927. The appellants in this case respectfully contend that the patent in suit should not have been declared invalid by the Court, that there were issues as to material facts existing in this case, and that the granting of the summary judgment was improper.

The Courts have held that validity of a patent is not an issue rightfully disposed of by summary judgment. The case of *Baker v. First Nat. Stores,* 64 F. Supp. 979 states as follows:

> "In the final analysis, what the defendant is really attempting to do is attack the validity of the patent on a motion for summary judgment. Since the Patent Office has granted a patent on this device there is at least some color of patentable invention, and the plaintiff is entitled to his day in court on these issues. Patent validity is an issue not rightly disposed of by summary judgment."

Further supporting this position is the case of *American Optical Co. v. New Jersey Optical Co.,* 58 F. Supp. 601, at page 605 where it is stated:

> "In the usual infringement case where the validity or scope of the patent is in issue the question cannot be decided without the aid of expert testimony and reference to file wrappers and prior art. Such an issue is not rightly disposed of by summary judgment."

Even assuming that summary judgment was available to challenge the validity of the patent (and there are cases so holding), the appellants respectfully urge that there were questions of material fact which had to be determined, thereby eliminating the availability of summary judgment.

The patent in suit was issued for a process of quick-freezing individual raw onion pieces. Appellee contends the process would have been obvious at the time of the invention to a person having ordinary skill in the art. However, appellants' position is that the uniqueness of their patent exists in (1) the process of individual (2) quick-freezing of (3) raw onion

pieces (4) at substantially ambient temperatures, i.e., without being subjected to any heat or blanching step.

It is this combination of steps which appellants claim as their invention, and which the Patent Examiner found constituted an allowable claim. Although some of the individual steps of the process may have been known to the prior art, the combination of the steps into the patented process was not known to the prior art. (See Motion Ex. B, pp. 41-46.) None of the publications relied upon by appellee deal with the specific process of quick freezing individual raw onion pieces in the manner specified in the patent, and it is significant that all of the publications relied upon by appellee relating to the prior art were before the Patent Examiner when the patent was allowed. (Motion Ex. B, pp. 10 and 38.)

The question of material fact which the Court should have recognized appellants were entitled to have tried was: Is the combination of steps the subject of the claim of U. S. Letters Patent No. 2,950,203 a patentable invention in the light of the state of the prior art and the laws pertaining to patents?

NON-INFRINGEMENT NOT ESTABLISHED BY APPELLEE

Although appellee goes to great lengths to describe the process which it employs in Walla Walla, Wash., and Nampa, Idaho, plants, there is no unequivocal denial of infringement of appellants' patented process at any place in the record, with the

exception of the denial in its answer. Moreover, the appellee admits preparing frozen onions at Avon, N.Y. (Clerk's Transcript 62, line 14), but mentions nothing about the process employed there anywhere else in the record. This also raises another issue as to a material fact upon which appellants should have the right of trial.

CONCLUSION

Appellants respectfully submit that the granting of summary judgment was improper in this case, and that appellants should have their day in Court on the issues of the case.

Dated, Stockton, California,
December 1, 1967.

Respectfully submitted,
CHARLES A. ZELLER,
Attorney for Appellants.

CERTIFICATE OF COUNSEL

I certify that, in connection with the preparation of this brief, I have examined Rules 18, 19 and 39 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing brief is in full compliance with those rules.

CHARLES A. ZELLER,
Attorney for Appellants.